

REMARKS

In light of the above-amendments and remarks to follow, reconsideration and allowance of this application are requested.

The drawings have been objected to under 37 C.F.R. 1.83(a) because they consist solely of empty boxes and fail to show any of the detail as described in the specification. In accordance with Examiner's suggestion the attached Request for Approval of Drawing Changes requests that Figs. 1-8 be amended to add labels to the boxes. It is requested that the amendments to Figs. 1-8 be approved.

Claims 30-34, 38-42, 46-49 and 51-55 have been rejected under 35 U.S.C. §102(b) as being anticipated by U.S. Patent No. 5,586,260 (Hu). Applicants respectfully traverse this rejection.

Hu describes that his invention resides in an authentication gateway system for authenticating a client for a server when the client and server have different security mechanisms. (Col. 2, lines 26-28; col. 3, lines 11-15). The authentication gateway obtains and saves security credentials for the client, returning an access key to the client. (Col. 2, lines 32-35; col. 5, line 65 to col. 6, line 21). Also, Hu describes the use of an access control list (ACL) in the server. (Col. 4, lines 59-64). However, contrary to the Examiner's assertion, Hu does not teach or suggest "**distributively and dynamically** configuring the security of the network to address new modes of attack" (emphasis added) by sending to the devices of the network security parameters for configuring a firewall in the device, as called for in amended independent claims 30, 38, 46 and 51. The support for recitations now recited in independent claims 30, 38, 46 and 51 are found on page 11, lines 2-14 and page 12, lines 5-7 of the specification.

Only the present invention teaches or suggest configuring security parameters used **in devices themselves** distributively and dynamically from the authentication management server, by transmitting security parameters distributively to devices of the network, as required in amended independent claims 30, 38, 46 and 51. The distribution is realized by managing the authenticating and security levels of devices before sending the security parameters to the devices. Thus, the devices have firewalls that can be configured by the server.

Of course, a rejection based on 35 U.S.C. §102 as the present case, requires that the cited reference disclose each and every element covered by the claim. Electro Medical Systems S.A. v. Cooper Life Sciences Inc., 32 U.S.P.Q.2d 1017, 1019 (Fed. Cir. 1994); Lewmar Marine Inc. v.

Barient Inc., 3 U.S.P.Q.2d 1766, 1767-68 (Fed. Cir. 1987), cert. denied, 484 U.S. 1007 (1988); Verdegaal Bros., Inc. v. Union Oil Co., 814 F.2d 628, 631, 2 U.S.P.Q.2D 1051, 1053 (Fed. Cir.), cert. denied, 484 U.S. 827 (1987). The Federal Circuit has mandated that 35 U.S.C. 102 requires no less than "complete anticipation ... [a]nticipation requires the presence in a single prior art disclosure of all elements of a claimed invention arranged as in the claim." Connell v. Sears, Roebuck & Co., 772 F.2d 1542, 1548, 220 U.S.P.Q. 193, 198 (Fed. Cir. 1983); See also, Electro Medical Systems, 32 U.S.P.Q. 2d at 1019; Verdegaal Bros., 814 F.2d at 631.

In view of the foregoing differences, it is respectfully submitted that Hu does not anticipate or render obvious the present invention as now recited in independent claims 30, 38, 46 and 51, and therefore, claims 30, 38, 46 and 51 (and dependent claims 31-34, 39-42, 47-49 and 52-55) are patentably distinct over Hu. It is respectfully requested that the rejection of claims 30-34, 38-42, 46-49 and 51-55 be withdrawn.

Moreover, contrary to the Examiner's assertion Hu does not teach or suggest that "the security parameters comprise a list of authorized computer client/server applications and information enabling each device to analyze messages related to said client/server application" as call for in claims 31, 39, 47 and 52. As admitted by the Examiner, Hu merely describes that the server uses an access control (ACL) to determine whether a client seeking access has been duly authorized. (See Office Action, paragraph 4; Hu: col. 4, lines 59-61).

Claims 35-37, 43-45, 50 and 56-58 have been rejected under 35 U.S.C. 103(a) as being unpatentable over Hu in view of U.S. Patent No. 6,658,565 (Gupta et al.). Applicant respectfully traverses this rejection.

Gupta et al. describes a technique for distributing processing loads among intermediate stations of a computer inter-network. But, Gupta et al. is not suggestive of "**distributively and dynamically** configuring the security of the network to address new modes of attack" (emphasis added) by sending to the devices of the network security parameters for configuring a firewall in the device. These, of course, are features recited by amended independent claims 30, 38, 46 and 51 (and thus included in dependent claims 35-37, 43-45, 50 and 56-58) and **not found** in Gupta et al. Hence, the addition of Gupta et al. does not cure the aforementioned deficiencies of Hu.

In view of the foregoing differences, it is respectfully submitted that the combination of Hu and Gupta et al. does not render obvious claims 35-37, 43-45, 50 and 56-58. It is respectfully

requested that the rejection of claims 35-37, 43-45, 50 and 56-58 under 35 U.S.C. §103 be withdrawn.

Further, there is no motivation in Hu or in Gupta et al. to suggest that the teachings of these two references should be combined. In re Sernaker, 217 U.S.P.Q. 1, 6 (Fed. Cir. 1983); SmithKline Diagnostics, Inc. v. Helena Laboratories Corp., 8 U.S.P.Q. 2d 1468, 1475 (Fed. Cir. 1988); In re Fritch, (Fed. Cir. 1992) 91-1318; In re Laskowski, 10 U.S.P.Q. 2d 1397, 1299 (Fed. Cir. 1989); In re Fine, 5 U.S.P.Q. 2d 1596, 1598 (Fed. Cir. 1988).

The decision of In re Geiger, 2 U.S.P.Q. 2d 1276 (1987) is quite relevant. There, the Federal Circuit stated:

“Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.”

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“At best in view of these [prior art] disclosures, one skilled in the art might find it obvious to try various combinations of these known [agents]. However, this is not the standard of 35 U.S.C. Section 103.”

Moreover, absent applicants' disclosure, there appears to be absolutely no reason to add Gupta et al. to Hu so as to provide a method and system for distributively and dynamically securing a communications network, especially since these two references are concerned with completely different problems. In fact, the only reason one might turn to Gupta et al., if at all, is because of the hindsight gleaned from applicant's own disclosure. The Federal Circuit has been consistent in warning against hindsight reconstruction of the prior art. As pointed out in Uniroyal v. Redkin-Wiley, 5 U.S.P.Q. 2d, 1434, 1438 (Fed. Cir. 1988):

“When prior art references require selective combination by the court to render obvious a subsequent invention, there must be some reason for the combination other than the hindsight gleaned from the invention itself. ...Something in the prior art as a whole must suggest the desirability, and thus the obviousness, of making the combination.”

* * *

“...it is impermissible to use the claims as a frame and the prior art references as a mosaic to piece together a facsimile of the claimed invention.”

In Uniroyal, the CAFC referred to Lindemann Maschinenfabrik GmbH v. American Hoist & Derrick Company, 221 U.S.P.Q. at 489, to conclude that “the mere fact that a device or process utilizes a known scientific principal does not alone make that device or process obvious.” 5 U.S.P.Q. 2d at 1440.

In Orthopedic Equipment Company, Inc. v. United States, 217 U.S.P.Q. 193-199 (Fed. Cir. 1983), the Federal Circuit warned,

“The difficulty which attaches to all honest attempts to answer this question [of obviousness based upon a combination of prior art] can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of nonobviousness in a court of law.”

In reversing an Examiner's rejection based upon obviousness, wherein the Examiner concluded that a claimed apparatus is shown simply by turning a prior art reference “upside down,” the CAFC ruled:

“The mere fact that the prior art could be so modified would not have made the modification obvious unless the prior art suggested the desirability of the modification.”

In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984), and citations noted therein.

Further, the prohibition against combining references in the absence of a prior art suggestion or motivation to do so is strengthened if the references to be combined are unrelated and from nonanalogous fields. In the present case, there is no relationship between Hu and Gupta et al.; Hu relates to an authentication gateway system for authenticating a client for a server when the client and server have different security mechanisms whereas Gupta et al. relates to a technique for distributing processing loads among intermediate stations of a computer inter-network. Even on the face of these two patents, they are from nonanalogous fields (note the areas of classification and fields of search indicated on each patent). The CCPA has held that where two patents relate to nonanalogous arts, they may not properly be combined to form a basis for rejection. In re Lobl, 108 U.S.P.Q. 229, 231 (CCPA 1955). The court there found that

it was not likely for one seeking to produce an improvement in the field to which the application related to look to a totally different art for suggestions.

This doctrine of nonanalogous art has been applied in In re Van Wanderham, 154 U.S.P.Q. 20 (CCPA 1967). In that case, the claimed subject matter was directed to the rapid cooling of fuel. The applied prior art was concerned with the quenching of a specimen in a cooling liquid, as suggested in the cutlery art. Although this prior art was concerned with rapid cooling, the court clearly ruled that the cutlery art from whence the reference was obtained was far removed from the subject matter of the application. Hence, the prior art reference was not evidence of the obviousness of the claimed device.

In In re Imperato, 179 U.S.P.Q. 730 (CCPA 1973), the CCPA observed that different references from nonanalogous arts, if combined, would give the beneficial result achieved by the claimed subject matter. However, it was ruled that such references could not properly be combined to render the claimed invention obvious in the absence of a specific teaching to permit the combination. See also Ex parte Vomstein, 180 U.S.P.Q. 333 (PTO Bd. of App. 1973) which ruled that it is not obvious to modify a basic reference in the art to which a patent application pertains with a secondary reference from an unrelated art.

The CCPA reiterated its position that nonanalogous art cannot be considered pertinent prior art under 35 U.S.C. §103 in In re Pagliaro, 210 U.S.P.Q. 888, 892 (CCPA (1981), wherein the Court quoted from In re Wood, 202 U.S.P.Q. 171, 174 (CCPA 1979):

"In resolving the question of obviousness, we presume full knowledge by the inventor of all prior art in the field of his endeavor. However, with regard to prior art outside the field of his endeavor, we only presume knowledge from those arts reasonably pertinent to the particular problem with which the inventor was involved ... The rationale behind this rule precluding rejections based on the combination of teachings of references from nonanalogous art is the realization that an inventor could not possibly be aware of every teaching in every art. Thus, the attempt

to more closely approximate the making of an invention by only presuming knowledge by the inventor of prior art in the field of his endeavor and in analogous arts.

"The determination that a reference is from a nonanalogous art is therefore twofold. First, we decide if the reference is within the field of the inventor's endeavor. If it is not, we proceed to determine whether the reference is reasonably pertinent to the particular problem with which the inventor was involved."

Using its rule from Wood, the CCPA found in Pagliaro that the reference was not within the field of the inventor's endeavor and it was not pertinent to the inventor's problem. In the present case, Gupta et al. is not within the field of applicants' endeavor and it is not pertinent to the problem of distributively and dynamically securing a communications network.

In view of the foregoing, it is respectfully submitted that one of ordinary skill in the art, after reading and understanding Hu, would not even turn to Gupta et al. -- and if he did, he would not understand how or why Gupta et al. should be combined with Hu.

Statements appearing above in respect to the disclosures in the cited references represent the present opinions of the applicants' undersigned attorney and, in the event that the Examiner disagrees with any of such opinions, it is respectfully requested that the Examiner specifically indicate those portions of the reference providing the basis for a contrary view.

Applicants' representative agrees with the Examiner's implicit finding that the prior art made of record and not relied upon is not as relevant to the claimed invention as Hu and Gupta et al.

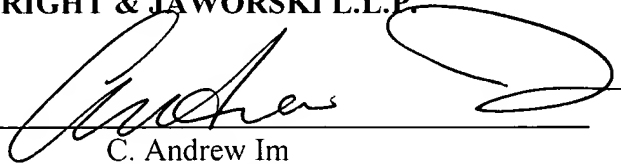
Accordingly, it is respectfully maintained that all rejections and objections have been overcome, and that the present application is now in condition for formal allowance.

No fee is believed to be due, however, should a fee become due the Commissioner is hereby authorized to deduct any fee associated with this filing from Deposit Account No. 500624.

Respectfully submitted,

FULBRIGHT & JAWORSKI L.L.P.

By

A handwritten signature in black ink, appearing to read "C. Andrew Im", is written over a horizontal line.

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